REMARKS

35 U.S.C. § 103 (a)

Claims 1 to 3 and 5 stand finally rejected under § 103 as allegedly unpatentable over Akasaki et al. (U.S. Pat. No. 5,075,487). The '487 patent discloses fluorene derivatives that are useful as intermediates in preparing compounds having utility as electrophotographic photoreceptors while the present invention is directed to compounds that are useful for treating cancer.

A person of ordinary skill in the art of cancer treatment is not likely to know about the cited prior art reference, which relates a totally different field of technology. Because the cited reference is from a field of technology that is completely unrelated to the present invention, it should not be considered analogous prior art. Accordingly, one skilled in the art would not have had reason to consider it in solving the problem at hand, namely, for compounds useful for treating cancer. *See*, M.P.E.P. § 2141.01 (a). The Federal Circuit has opined on the subject of analogous art and has decided that for purposes of determining whether a reference is analogous prior art, one of the following two inquiries must be met;

(1) either the art is from the same field of endeavor, or

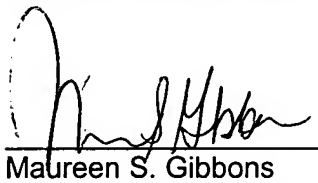
(2) if the reference is not within the same field of the inventor's endeavor, the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

See, *In re Clay*, 23 U.S.P.Q. 2d 1058, 1060 (Fed. Cir. 1992). Under the *Clay* test, the cited reference would not be considered analogous art because it is clearly unrelated to the art of cancer treatment and therefore there is no reason to believe that one skilled in the art would be familiar with it, as discussed above.

Although the Office Action cites the *Obiaya* case in support of the rejection, it is significant that in that case, both the cited references and the claimed invention were from the same field of technology and therefore the reference was indeed analogous art. 227 U.S.P.Q. 58, 60 (we believe that the references clearly distinguish each of the features in *similar apparatus* such that one skilled in this art having these references available would have found the claimed invention to be obvious)(emphasis added.) Accordingly, Applicants do not believe that the *Obiaya* case supports the present rejection. Withdrawal of the rejection is respectfully requested.

Applicants believe that the present claims are in condition for allowance. An Office Action to that effect is respectfully requested.

Respectfully submitted,



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